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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,131	07/14/2003	Shane E. Weyant	DB001016-001	6900
23990	7590	01/11/2006	EXAMINER	
DOCKET CLERK P.O. DRAWER 800889 DALLAS, TX 75380			MAYO, TARA L	
			ART UNIT	PAPER NUMBER
			3671	

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/619,131	Applicant(s) WEYANT ET AL.	
	Examiner Tara L. Mayo	Art Unit 3671	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7 and 28-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7 and 28-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 28 is rejected under 35 U.S.C. 102(b) as being anticipated by Rainey (U.S. Patent No. 6,168,351 B1).

Rainey '351, as seen in Figure 2, shows a wale (42) for use in bracing a retaining wall (10), said wale comprising:

with regard to claim 28,

a back wall (48) having a first opening therein and operable for receiving a tieback rod therethrough;

a front wall (50) having a channel formed therein extending from a first end of said wale to a second end of said wale and having a second opening therein and operable for receiving the tieback rod therethrough;

a plurality of connecting walls (44, 46) connecting said back and front walls to form at least one chamber between said back wall and said front wall; and wherein said wale is of a unitary construction.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 2, 6, 28, 30, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weber (U.S. Patent No. 5,435,669A) in view of Fox (U.S. Patent No. 5,765,970A).

Weber '669, as seen in Figures 7A through 7E, shows a wale (87, 74) comprising:
with regard to claims 1 and 28,

a back wall (74);

a front wall (88) having a channel (89) formed therein and extending from a first end of the wale to a second end of the wale; and

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a plurality of connecting walls (76, 77) connecting said back and front walls to form at least one chamber between said back wall and said front wall;

with regard to claims 2 and 28,

wherein said wale is of a unitary construction and said plurality of connecting walls includes a top wall and a bottom wall, and wherein a single chamber is formed between said back wall and said front wall;

with regard to claim 6,

a back wall (75);

a front wall (78) having a top portion and a bottom portion interconnected by a C-shaped channel portion;

a top wall (76) connecting said back wall to said top portion; and

a bottom wall (77) connecting said back wall to said bottom portion to form a chamber between said back wall and said front wall;

with regard to claim 33,

wherein said back wall and said channel each comprise an opening (81) therein and operable for receiving said tieback rod therethrough; and

with regard to claim 34,

wherein said back wall and said C-shaped channel portion each comprise an opening therein operable for receiving said tieback rod therethrough.

Weber '669 further discloses the wale being of a unitary construction and said plurality of connecting walls including a top wall and a bottom wall.

Weber '669 shows all of the features with the exception(s) of:
with regard to claim 1,

the channel having a depth sufficient such that when the wale is secured to the retaining wall, a tieback rod passing through the wale and a fastener do not protrude from the channel; and
with regard to claims 1, 6 and 30,

an upper reinforcing wall, a lower reinforcing wall, and a plurality of chambers formed between the back wall and the front wall.

Fox '970, as seen in Figure 1, shows a molded plastic retaining wall structure (12) comprising upper and lower reinforcing walls (14) extending between front and back walls to provide internal stiffening (col. 2, lines 30 through 39), the upper and lower reinforcing walls forming a plurality of chambers between the back and front walls.

With regard to claims 1 and 6, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the channel of the device shown by Weber '669 of a depth sufficient such that when the wale is secured to the retaining wall, a tieback rod passing through the wale and a fastener do not protrude from the channel, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

With regard to claims 1, 6 and 30, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device shown by Weber '669

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such that it would further include upper and lower reinforcing walls thereby forming a plurality of reinforcing chambers as taught by Fox '970 and connecting the back wall to the C-shaped channel portion in the front wall. The motivation would have been to provide the wale with internal reinforcements.

6. Claims 4, 5, 7, 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weber (U.S. Patent No. 5,435,669A) in view of Fox (U.S. Patent No. 5,765,970A), as applied to claims 1, 6 and 28 above, and further in view of *Enduro Systems DuroThread Fastener & Hanging Systems*.

The combination of Weber '669 and Fox '970 teaches all of the features of the claimed invention with the exception(s) of:

with regard to claims 4, 7 and 31,

the wale further comprising a pultruded composite material; and

with regard to claims 5 and 32,

the composite material being fiberglass reinforced plastic resin impregnated composite.

Enduro Systems shows a fastener system comprising a tieback rod and a clamp, the fastener system comprising a fiberglass reinforced plastic resin impregnated composite for applications requiring corrosion resistant and/or non-conductive fasteners.

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With regard to claims 4, 5, 31 and 32, it would have been obvious to one having ordinary skill in the art of retaining walls at the time the invention was made to modify the device shown by the combination of Weber '669 and Fox '970 such that the wale would comprise a fiberglass reinforced plastic resin impregnated composite as suggested by *Enduro Systems*. The motivation would have been to enhance the integrity of the overall wall structure with the use of a corrosion resistant rod.

7. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rainey (U.S. Patent No. 6,168,351 B1).

Rainey '351 discloses all of the features of the claimed invention with the exception(s): with regard to claim 29,

the channel having a depth sufficient such that when the wale is secured to the retaining wall, a tieback rod passing through the wale and a fastener do not protrude from the channel.

With regard to claim 29, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the channel of the device shown by Rainey '351 of a depth sufficient such that when the wale is secured to the retaining wall, a tieback rod passing through the wale and a fastener do not protrude from the channel, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Response to Arguments

8. Applicant's arguments filed 31 October 2005 have been fully considered but they are not persuasive.

In response to Applicant's statement that Rainey '351 fails to teach a wale of unitary construction, the Examiner contends that the prior art wale meets the definition of "unitary"; namely, the pieces form a unit, they create a whole. *Dictionary.com* defines "unitary" as--

- ¹. Of or relating to a unit.
- ². Having the nature of a unit; whole.
- ³. Based on or characterized by one or more units.

In response to applicant's argument that Weber '669 fails to teach a wale for a retaining wall, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

In response to Applicant's statement that Fox '970 fails to teach a channel, the Examiner notes that the prior art was only relied upon for a teaching of upper and lower reinforcing walls. Therefore, any arguments relating to the channel are irrelevant to the above maintained rejection.

In response to Applicant's statements regarding the prior rejection of claims 4, 5, 31 and 32, the Office action has been corrected to properly refer to the combination of Weber '669, Fox '970 and *Enduro Systems* instead of Rainey '351 and *Enduro Systems*. The Examiner believes

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her intent was clear since claims 4 and 5 depend from claim 1, claim 1 being previously rejected as unpatentable over the combination of Weber '669 and Fox '970.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tara L. Mayo whose telephone number is 571-272-6992. The examiner can normally be reached on Monday through Friday 8:30 AM to 5:00 PM.

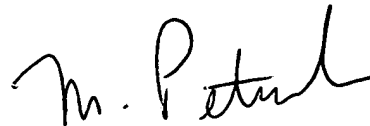
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will can be reached on 571-272-6998. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Handwritten signature of JBL in black ink.

07 January 2006

Handwritten signature of Meredith Petravick in black ink.

Meredith Petravick
Primary Examiner